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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	88712080
Applicant	Danica Patrick Brands, LLC
Applied for Mark	DANICA
Correspondence Address	BRADLEY J WALZ BARNES & THORNBURG LLP 225 SOUTH SIXTH STREET SUITE 2800 MINNEAPOLIS, MN 55402 UNITED STATES Primary Email: trademarks-mi@btlaw.com Secondary Email(s): bwalz@btlaw.com 612-367-8756
Submission	Applicant's reply brief
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Filer's Name	Bradley J. Walz
Filer's email	trademarks-mi@btlaw.com, bwalz@btlaw.com
Signature	/Bradley J. Walz/
Date	08/27/2021

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

In re Application of: Danica Patrick Brands, LLC
Application No.: 88/712,080
Filed: December 2, 2019
Mark: DANICA

APPLICANT’S REPLY BRIEF

INTRODUCTION

The Examining Attorney’s conclusion that “RANCH” does not modify the term “DANIKA” demonstrates he did not follow the common-sense fact that dissection and recombination of the phrase components may not capture the message of a whole phrase. [Aug. 7, 2021, Office Action, TSDR, p 8]; see *Juice Generation, Inc. v. GS Enterprises LLC*, 115 U.S.P.Q.2d 1671, 1674 (Fed. Cir. 2015). In this case, to the extent recognized as a given name, DANIKA is weak, and afforded a narrow scope of protection. Accordingly, consumers will look to the differences between Applicant’s mark and the Cited Mark to distinguish the marks.

The Alcohol and Tobacco Tax and Trade law concerning the use of RANCH changes the message conveyed by the DANIKA RANCH mark to something that is clearly different from the message conveyed by Applicant’s mark. Therefore, even if used in connection with identical goods, there is no likelihood of confusion between the DANIKA RANCH mark and Applicant’s mark.

An unrestricted goods description is presumed to encompass “all goods of the type described,” but this presumption does not extend to goods that *per se* violate federal law. The

goods description in the Cited Mark covers “wine,” but federal law limits the type of wine a winemaker can offer under a name that uses the term RANCH. This does not amount to reading a restriction in the Cited Mark just like identifying what are “normal channels of trade” does not read a restriction into the Cited Mark. In this case, it is undisputed that Danika Ranch is a real farm in Napa Valley, CA, and the only grapes grown at the Danika Ranch are chardonnay and sauvignon blanc grapes. Therefore, because of the Alcohol and Tobacco Tax and Trade law, the only type of wine that is legal for Stag’s Leap Wine Cellars, LLC (“Stag’s Leap”) to produce is chardonnay and sauvignon blanc.

The significance of the legal use of the DANIKA RANCH mark consisting of only chardonnay and sauvignon blanc wine is that it informs the differences in the normal channels of trade. The evidence clearly shows that chardonnay and rosé wine are not sold in the same trade channels. The distinct trade channels coupled with the heightened care exercised by the average wine consumer demonstrates that confusion between the Cited Mark and Applicant’s mark is unlikely. Therefore, Applicant respectfully requests that the Board reverse the registration refusal.

ARGUMENT

Similarity of the Marks

The Examining Attorney argued “[t]he term ‘DANIKA’ in the registered mark creates the dominant commercial impression in the mind of the consumer.” [Aug. 7, 2021, Office Action, TSDR, p. 6] The Examining Attorney offered no evidence to support this conclusion. In fact, Applicant offered the only evidence in the record concerning how the relevant consumer refers to DANIKA RANCH chardonnay wine, which demonstrates that DANIKA is not the dominant portion of the DANIKA RANCH mark. [Feb. 17, 2021, TEAS Request for Reconsideration after FOA, TSDR p. 34] Consumers refer to the mark as DANIKA RANCH not DANIKA. [*Id.*] Instead,

the Examining Attorney relied on general guidelines that may or may not be true in a particular case; namely, DANIKA is the first word in DANIKA RANCH and Stag's Leap voluntarily disclaimed the term RANCH. [Aug. 7, 2021, Office Action, TSDR, pp. 5-7]; see *Trek Bicycle Corp. v. Christina Isaacs*, 2021 WL 3468080 (T.T.A.B. Aug. 4, 2021). The evidence shows these guidelines are not true in this case.

There is no mechanical test to select a “dominant” element of a mark. *Id.* “If the common element of two marks is ‘weak’ in that it is generic, descriptive, or highly suggestive of the named goods or services, it is unlikely that consumers will be confused unless the overall combinations have other commonality.” *Id.* (citing *Juice Generation, Inc. v. GS Enterprises LLC*, 115 U.S.P.Q.2d 1671, 1674-75 (Fed. Cir. 2015) (remanded for consideration of whether and to what degree the phrase PEACE & LOVE was suggestive or descriptive in the food-service industry); *In re Bed & Breakfast Registry*, 229 U.S.P.Q. 818, 819 (Fed. Cir. 1986) (reversing TTAB’s holding that contemporaneous use of BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes, and BED & BREAKFAST INTERNATIONAL for room booking agency services, is likely to cause confusion, Opposition No. 91232164 because, inter alia, the descriptive nature of the shared wording weighed against a finding that the marks are confusingly similar); *In re UT Fidem Foundation*, Serial No. 88592284 (T.T.A.B. Aug. 24, 2021) (reversing the registration refusal holding that the shared phrase KEEP THE FAITH is weak and consumers will look to the differences in Applicant’s and Registrant’s marks to distinguish them); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 U.S.P.Q.2d 1066, 1076 (T.T.A.B. 2011) (because the shared term “Elements” is suggestive, consumers viewing applicant’s mark ZU ELEMENTS will “focus on the larger, more prominent and more distinctive term, ZU, while attributing a meaning to the latter, smaller term ELEMENTS that is suggestive of apparel items”); *In re Christian Dior*,

S.A., 225 U.S.P.Q. 533, 534 (T.T.A.B. 1985) (“where ... the [service] marks in question are highly suggestive or merely descriptive or play upon commonly used or registered terms, the addition of . . . other material to the assertedly conflicting [service] mark has been determined sufficient to render the marks as a whole sufficiently distinguishable.”).

Given names, like surnames, are *per se* weak marks; thus, entitled to a narrow scope of protection. *Aileen, Inc. v. Eileen Togs, Corp.*, 188 U.S.P.Q. 698 (T.T.A.B. 1975); *In re Select Jewelry Inc.*, 2014 WL 1390511 (T.T.A.B. March 27, 2014). The Examining Attorney argued that the evidence demonstrates there is widespread use of the DANIKA name. [Aug. 7, 2021, Office Action, TSDR, pp. 11-13] Therefore, assuming the average wine consumer recognizes DANIKA as a given name, it is undisputed that it is a weak given name, entitled to a narrow scope of protection.

DANIKA and DANICA are not identical. The Cited Mark contains the word RANCH, which is not present in Applicant’s Mark. Moreover, despite the Examining Attorney’s argument to the contrary, adding the term RANCH has a meaningful effect on the overall commercial impression on the DANICA RANCH mark and results in the DANIKA RANCH and DANICA marks having no other commonality.

“The marks must be considered in the way they are used and perceived.” *In re the Hearst Corporation*, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992). While this “does not preclude consideration of components of a mark; it requires heeding the common-sense fact that the message of a whole phrase may well not be adequately captured by a dissection and recombination [of the components].” *Juice Generation*, 115 U.S.P.Q.2d at 1674 (citing *Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 1007 (C.C.P.A. 1981))(emphasis added). “Marks tend to be perceived in

their entirety, and all components thereof must be given appropriate weight.” *Hearst*, 25 U.S.P.Q.2d 1238.

In the *Hearst* case, the Board affirmed the refusal to register the mark VARGA GIRL (GIRL was found to be merely descriptive and VARGAS is a surname) for calendars based on a prior registered mark for VARGAS also for calendars. *Id.* The Federal Circuit found that “[t]he appearance, sound, sight, and commercial impression of VARGA GIRL derives significant contribution from the component ‘girl.’” *Id.* at 1239. Therefore, the Federal Circuit reversed the Board’s decision to stress the VARGA portion of the composite mark, which the Court held inappropriately changed the mark. *Id.* “When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely.” *Id.*

Like the *Hearst* decision, DANICA and DANIKA are spelled differently. Additionally, the appearance, sound, sight, and commercial impression of DANIKA RANCH derives significant contribution from the component RANCH. The Examining Attorney’s speculation that the average wine consumer will primarily think that DANIKA RANCH is just some ranch associated with a woman named Danika is not based on how the mark is used or perceived. [Aug. 7, 2021, Office Action, TSDR, p. 8]; *see Hearst*, at 1239.

The Alcohol and Tobacco Tax and Trade law regarding the use of the RANCH term tells us how the average wine consumer will perceive the DANIKA RANCH mark. *See Hearst*, at 1239. This rule demonstrates that the average wine consumer will primarily perceive the DANIKA RANCH mark to mean that the vast majority, if not all, of the chardonnay grapes used to produce the chardonnay wine came from the farm located in Napa Valley, CA named Danika Ranch. [Aug. 3, 2020, Response to Office Action, TSDR pp. 8-12.] In fact, the Examining Attorney’s speculation that consumers will merely understand that Danika Ranch is some random ranch

owned by someone named Danika is precisely the outcome the Alcohol and Tobacco Tax and Trade intended to prevent with its law. Wine Labeling Amendments, 59 Fed. Reg. 14551-01, 1994 WL 97859 (March 29, 1994). Alcohol and Tobacco Tax and Trade specifically implemented the wine labeling law “to prevent deception of the consumer, and to provide the consumer with adequate information as to the identity and quality of the product.” *Id.*

By itself, DANIKA is a weak, given name and the composite DANIKA RANCH mark is a weak, geographically or merely descriptive mark. Any way the Cited Mark is examined, the inescapable conclusion is that it is a weak mark that is entitled to a narrow scope of protection. Other than a weak, given name with different spellings, there is no commonality with Applicant’s mark. When the term RANCH is given fair weight confusion between the DANIKA RANCH and DANICA marks even when used in connection with identical goods is unlikely.

Channels of Trade and Class of Consumers

The Examining Attorney did not rebut Applicant’s recitation of the law concerning the basis for the presumption applicable to an unrestricted description; namely, the possibility of the trademark owner expanding the use of the mark to goods not yet offered under lies the presumption. *See Cosmetic Warriors Limited v. Trang Diem Tran*, 2017 WL 2876828, *7 (T.T.A.B. June 2, 2017) (holding the goods identified in the application and registrations “could change at any time”). In the case of the Cited Mark, expanding the use of the DANIKA RANCH mark beyond chardonnay or sauvignon blanc wine is impossible. [June 7, 2021, Appeal Brief, TTABVUE, p. 12]

“Use of a mark in connection with unlawful shipments in interstate commerce is not use of a mark in commerce which the [Office] may recognize.” *Coahoma Chemical Co., Inc. v. Smith*, 113 U.S.P.Q. 413 (Com’r Pat. & Trademarks 1957). Thus, the goods to which the mark is applied

must comply with all applicable federal laws. *See In re Brown*, 119 U.S.P.Q.2d 1350, 1351 (T.T.A.B. 2016) (citing *In re Midwest Tennis & Track Co.*, 29 U.S.P.Q.2d 1386, 1386 n. 2 (T.T.A.B. 1993) (noting that “[i]t is settled that the Trademark Act’s requirement of ‘use in commerce,’ means a ‘lawful use in commerce’”)); *In re Pepcom Indus., Inc.*, 192 U.S.P.Q. 400, 401 (T.T.A.B. 1976); TMEP §907. It would be a *per se* violation of the Alcohol and Tobacco Tax and Trade’s law to use the word RANCH to identify a wine where less than 95% of the wine making material for the wine came from a source other than the ranch named on the wine label. *In re Morgan Brown*, 119 U.S.P.Q.2d 1350 (T.T.A.B. 2016); 27 C.F.R. § 4.39(m).

Stag’s Leap must comply with the Alcohol and Tobacco Tax and Trade’s law concerning the use of the RANCH term. The Examining Attorney did not dispute that the Danika Ranch is a real farm in Napa Valley, CA and that the farm produces only chardonnay and sauvignon blanc grapes. [June 7, 2021, Appeal Brief, TTABVue, p. 12] The traditional presumption that an unrestricted identification encompasses “all goods of the type described” does not extend to goods that would violate federal law. *See Brown*, 119 U.S.P.Q.2d at 1351. The opposite conclusion would create an absurd result. In this case, the Cited Mark does not get the benefit of all types of wine when it is legal for Stag’s Leap to use the Cited Mark only on chardonnay or sauvignon blanc wines. *See id*; *Cosmetic Warriors Limited*, 2017 WL 2876828, *7.

The Examining Attorney did not rebut Applicant’s evidence that the normal channels of trade for wine are liquor stores, bars, and restaurants. The Examining Attorney also did not rebut Applicant’s evidence that chardonnay wine is sold in a separate area of a liquor store than rosé wine and that chardonnay wine is listed in a separate section of a restaurant menu than rosé wine. Therefore, there is no overlap between the normal channels of trade for chardonnay wine and rosé wine.

In general, wine is not an impulse purchase. *See In re Folino Estate, LLC*, 2016 WL 5407754 (T.T.A.B. Sept. 12, 2016). In an article written by Gregory Carpenter and Ashelee Humphreys titled “What the Wine Industry Understands About Connecting with Customers” the authors summarized the results of a consumer survey they conducted writing: “[c]onsumers looking to buy a bottle of wine confront thousands of choices. In fact, many of the shoppers we spoke to described the experience as stressful; they were fearful of making a poor choice and looking ignorant or of missing an opportunity to make an evening more special.” [Feb. 17, 2021, TEAS Request for Reconsideration after FOA, TSDR p. 45] A consumer that is fearful of making a mistake will spend more time studying and comparing his or her wine options before making a purchasing decision. Consequently, the average wine consumer exercises care when making a purchase, which lessens the likelihood of confusion between the Cited Mark and Applicant’s mark.

CONCLUSION

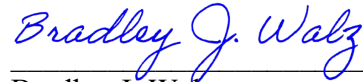
DANIKA is a weak, given name and the composite DANIKA RANCH mark is a weak mark that is entitled to a narrow scope of rights. Other than a different spelling of a weak, given name, the Cited Mark has no commonality with Applicant’s mark. When the term RANCH is given fair weight confusion between the DANIKA RANCH and DANICA marks even when used in connection with identical goods is unlikely.

The goods at issue are wine only and the traditional presumption that an unrestricted identification encompasses “all goods of the type described” does not extend to goods that would violate federal law. It is legal for Stag’s Leap to use the DANIKA RANCH mark only on chardonnay or sauvignon blanc wines. The normal and usual channels of trade for chardonnay wine and rosé wine are different. Finally, the average wine consumer exercises care when making a purchase and will not confuse the Cited Mark and Applicant’s mark.

There is no likelihood of confusion between Applicant's mark and the Cited Mark. Therefore, Applicant respectfully requests that the Board reverse the registration refusal and order the issuance of the notice of publication.

Respectfully submitted,

BARNES & THORNBURG, LLP



Bradley J. Walz

2800 Capella Tower

225 South Sixth Street

Minneapolis, MN 55402

Direct: (612) 367-8756

Email: bwalz@btlaw.com

Attorneys for Applicant

Danica Patrick Brands, LLC

Dated: August 27, 2021

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